

identify the parent application that has now issued as U.S. Patent 5,624,265. The title is amended in response to the Examiner's request at paragraph 2, page 2 of the Office Action dated April 16, 1997. Applicants note that the title as amended is not intended to limit the invention recited in the claims.

Claims 35, 38-41, 44-49, 52-54 and 97-99 are amended to clarify the claim language. For example, Claim 45 is amended to depend from Claim 44 thereby to provide antecedent basis for "said button code" required by the Examiner in paragraph 4 on page 3 of the above-identified Office Action. Moreover, Claim 47 found unclear by the Examiner is canceled and Claim 48 has been amended to recite a "code" that is supported in the specification, for example, at page 20, line 29, and page 26, lines 23-30. Claims 51 and 97-99 are amended in view of the Examiner's remarks at paragraph 4, page 3 of the above-identified Office Action. Specifically, Claim 46 is amended to recite "button" thereby to eliminate the requirement to recite "said data button" as suggested by the Examiner in reference to Claim 51.

Support for the above-described amendments to the claims can be found throughout the application. For example, the amendments to Claim 35 are supported by FIG. 2B and the related description, at page 32, line 35 to page 34, line 21, by FIGs. 6A-6H and the related description at page 54, line 33 to page 62, line 3, by page 19, line 16 and by page 65, line 10.

New Claim 101-120 are added to provide alternative recitation of Applicants' invention. Claims 101-120 are also supported throughout the specification. For example, support for Claim 101 can be found at page 21, line 11, for Claim 102 at page 26, line 28, page 27, lines 10 and 14, and page 36, line 34, for Claim 104 at page 122, line 18, for Claim 106 at

page 59, line 10, for Claims 107 and 108 at page 69, lines 29-31, for Claim 112 at page 41, lines 20-21, for Claim 115 at page 103, lines 26-29, for Claim 117 at page 70, lines 12-18.

Accordingly, Applicants respectfully request the Examiner to enter the above-discussed amendments. All claim amendments discussed above merely clarify the claim language, and are not intended to limit the scope of the claims, unless the claim language is expressly quoted in the following arguments to distinguish over prior art.

Claims 46-48 and 99 were rejected as being anticipated by U.S. Patent 5,335,079 (hereinafter "Yuen"). The Examiner stated at page 4 of the above-identified Office Action:

As per claims 46-68 and 99, the broadly claimed structure can be interpreted as the apparatus and method using compressed codes for recorder preprogramming of Yuen et al. Figs. 1-28 of Yuen et al broadly discloses the remote control for remotely controlling a host device having the housing (12, 80, 90, 300) including storage media with data selecting content (380) for the data selecting association with electronic content accessible by the host device (14, 70, 370), remote control circuitry having the signal transmitter (390) including the infrared light emitting diode (28, 340, 342, 344, 346, 348) capable of transmitting the wireless signal for causing the host device to respond to a button code received from the remote control to record video, audio, picture and text, and the data button (20, 22, 24, 26, 27, 168, 170, 302, 306, 308, 310, 312, 316, 318, 320, 322, 324, 326, 328, 330) having the human understandable content association with the data selecting content of the housing.

Yuen merely discloses an apparatus having "numerical keys 20" (col. 4, line 39) that must be operated in a sequence to enter a "G-code". Yuen states that the "G-code consists of 1

LAW OFFICES OF
SKJERVEN, MORRILL,
MacPHERSON, FRANKLIN
& FRIEL LLP

25 METRO DRIVE
SUITE 700
SAN JOSE, CA 95110
(408) 453-9200
FAX (408) 453-7979

368971 v1

- 12 -

SER. NO. 08/550,976

to 7 digits, although more could be used, and is associated with a particular program. A user would look up the G-code in a program guide and just enter the G-code on the remote controller 12" (col. 4, lines 15-19). Yuen also discloses additional keys that perform various functions. For example, Yuen states that "[t]he first program (PROG) key 26 enters the programming mode" (col. 4, lines 38-39).

Yuen et al. fail to disclose or suggest a "label indicative of specific information [to be] retrieved from [an external] source" as recited by Claim 46. Support for the amendment to Claim 46 can be found throughout the specification, including page 25, line 23, page 16, line 18 and in FIG. 1E. As noted above, Yuen merely discloses "numerical keys 20" (emphasis added; col. 4, line 1) used to enter a "G-code" that "consists of 1 to 7 digits" (col. 4, line 15). Even when a single digit is used in Yuen's apparatus (see col. 15, lines 39-41), such a single digit fails to indicate to the user "specific information to be retrieved" as recited by Claim 46 because the meaning of such a digit is unknown to a user without reference to a guide. Specifically, Yuen states that "[a] user would look up the G-code in a program guide" (col. 4, lines 17-18 and col. 15, lines 41-42).

Yuen also discloses a number of function keys labeled with words, e.g. a "first program (PROG) key 26" that when pressed causes Yuen's apparatus to enter the programming mode (col. 4, lines 38-39). Therefore, Yuen's non-numeric labels merely indicate functions and do not indicate "specific information [to be] retrieved... from [an external] source ..." as recited by Claim 46.

Moreover, Yuen's apparatus merely preprograms a "VCR to record a given television program" (emphasis added; col. 2, line 37 and lines 20-21). Yuen fails to disclose or suggest

LAW OFFICES OF
SKJERVEN, MERRILL,
MacPHERSON, FRANKLIN
& TRIEL LLP

25 METRO DRIVE
SUITE 700
SAN JOSE, CA 95110
(408) 453-9200
FAX (408) 453-7979

368971 v1

- 13 -

SER. NO. 08/550,976

BB

that specific information indicated by the label is to be "displayed by the host device in response to said wireless signal" as recited by Claim 46. Claim 46 is therefore patentable over Yuen's teachings for at least this additional reason.

Accordingly, Applicants respectfully request the Examiner to withdraw the prior art rejection of Claim 46 and Claims 48-49 and 51-54 that depend either directly or indirectly from Claim 46. New Claims 101, 102, 108 and 109 also depend either directly or indirectly from Claim 46, and are therefore also patentable for at least the same reasons as Claim 46.

Claims 99, 106 and 110-117 also distinguish over the teachings of Yuen for reasons similar to those discussed above in reference to Claim 46 by reciting either directly or indirectly a "label...indicative of specific information...". Note that the limitation "descriptive" recited by Claim 110 is narrower than the limitation "indicative" recited by Claim 46.

Claim 35 distinguishes over the teachings of Yuen for reasons similar to those discussed above in reference to Claim 46 because Claim 35 also recites a "label...indicative of specific information". Note that Claim 46 allows retrieval "from a source external to said host device..." whereas Claim 35 requires retrieval "from [a] removable storage media". In the rejection of Claim 35, the Examiner also cited U.S. Patent 5,457,780 granted to Shaw et al. However, Shaw et al. fail to cure the above-noted defects in the teachings of Yuen et al.

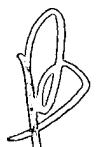
Specifically, Shaw et al. merely disclose a remote controller 116 (FIG. 1) that has a number of buttons. Shaw et al. fail to disclose that a button of remote controller 116 has any label, let alone a "label...indicative of specific information" as recited by Claim 35. Moreover, there is no motivation or suggestion in the combined teachings of Yuen and

B

Shaw et al. to combine the respective teachings in the manner suggested by the Examiner.

Therefore, Applicants respectfully submit that Claim 35 is patentable over the combined teachings of Yuen and Shaw et al. Claims 36-45, 97-98 and 107 also distinguish over the teachings of Yuen and Shaw et al. for reasons similar to those discussed above in reference to Claim 35, by reciting either directly or indirectly a "label indicative of specific information".

Claim 118 distinguishes over the teachings of Yuen, by reciting "a code that identifies specific information to be retrieved from a storage media...". Yuen apparently discloses transmission of numbers in response to pressing "numerical keys 20" (col. 4, line 1) wherein the numbers form a "compressed code" (col. 4, line 12) to be converted into "channel, date, time and length (CDTL) commands" (col. 4, lines 20-21) for use in "preprogramming" (col. 3, line 63) a "video cassette recorder/player" (col. 3, lines 65-66). Therefore, Yuen merely discloses codes used to perform functions, and fails to disclose or suggest "a code that identifies specific information" as recited by Claim 118. Therefore, Claim 118 and Claims 119 and 120 that depend from Claim 118 are patentable over the teachings of Yuen.



Accordingly, Applicants respectfully submit that all pending Claims 35-46, 48-49, 51-54 and 97-120 are allowable, and allowance thereof is respectfully requested. If the Examiner has any questions regarding any aspect of this application, the Examiner is respectfully requested to telephone the undersigned at (408) 453-9200, extension 1227.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on August 15, 1997.

S. Omkar

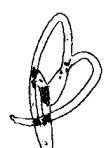
Attorney for Applicant(s)

Aug 15, 1997

Date

Respectfully submitted,


~~Omkar K. Suryadevara~~
Omkar K. Suryadevara
Attorney for Applicant(s)
Reg. No. 36,320



LAW OFFICES OF
SKJERVEN, MORRILL,
MacPHERSON, FRANKLIN
& FRIEL LLP

25 METRO DRIVE
SUITE 700
SAN JOSE, CA 95110
(408) 453-9200
FAX (408) 453-7979

368971 v1

- 16 -

SER. NO. 08/550,976